REMARKS

Claims 1, 2, 5-25 and 27-37 are rejected under 35 U.S.C. §102(e) as being anticipated by *de la Huerga* (U.S. 5,960,085). This rejection is respectfully traversed for the reasons set forth below.

Amended independent claims 1 and 21 now includes:

"1. (Currently Amended) A computer system comprising:

an authorized user identification device;

at least one processor coupled to the computer system;

a proximity range actuated identification signal detection circuit for receiving a wireless identification signal from the identification device, the wireless identification signal containing identification information regarding a user of the device;

a memory having means for determining whether the user of the identification device as indicated by the wireless identification signal, has authorized access to computer information accessible by the computer system; and

a memory having means for placing the computer system in a condition to deny access by placing the computer system in a lower power state in response to the identification signal detection circuit not having received, for a predetermined period of time, a wireless identification signal containing identification information from the user having authorized access.

21. (Currently Amended) A method for controlling access to computer information comprising:

providing an authorized user identification device;

providing a computer system;

sending a wireless identification signal by the identification device, the wireless identification signal including identification information regarding a user of the device;

receiving, independent of a conscious access action by the user, the wireless identification signal by a proximity range actuated detection circuit coupled to the computer system;

determining whether the user as indicated by the wireless identification signal has authorized access to computer information accessible by the computer system;

granting access to computer information accessible by the computer system if it is determined that the user as indicated by the wireless identification signal is authorized access, wherein the granting access to computer information accessible by the computer system further includes placing the computer system in a higher power state from a lower power state; and

denying access to computer information accessible by the computer system by placing the computer system in the lower power state if the computer system has not received for a predetermined period of time, a wireless identification signal containing identification information from the user having authorized access."

The PTO provides in MPEP § 2131..."To anticipate a claim, the reference must teach every element of the claim...". Therefore, to sustain this rejection the *de la Huerga* patent must contain all of the claimed elements of independent claims 1 and 21. However, the claimed "authorized user identification device; at least one processor coupled to the computer system; a proximity range actuated identification signal detection circuit for receiving a wireless identification signal from the identification device, the wireless identification signal containing identification information regarding a user of the device; a memory having means for determining whether the user of the identification device as indicated by the wireless identification signal, has authorized

access to computer information accessible by the computer system; and a memory having means for placing the computer system in a condition to deny access by placing the computer system in a lower power state in response to the identification signal detection circuit not having received, for a predetermined period of time, a wireless identification signal containing identification information from the user having authorized access." is not shown or taught in the *de la Huerga* patent. Therefore, the rejection is unsupported by the art and should be withdrawn.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. Of California,* 814 F.2d 628, 631, 2 USPQ2d 1051, contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

For these reasons, the rejection of independent claims 1 and 21, as now amended, should be withdrawn. Applicant submits that independent claims 1 and 21, along with the claims dependent therefrom, are allowable over *de la Huerga*.

Applicant further submits that the reference is defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP § 2142:

> ... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness...

The Federal Circuit has held that a reference did not render the claimed combination *prima facie* obvious in *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed.

Cir. 1988), because inter alia, the examiner ignored a material, claimed, temperature limitation which was absent from the reference. In variant form, the Federal Circuit held in *In re Evanega*, 829 F.2d I 110, 4 USPQ2d 1249 (Fed. Cir. 1987), that there was want of *prima facie* obviousness in that:

> The mere absence [from the reference] of an explicit requirement [of the claim] cannot reasonably be construed as an affirmative statement that [the requirement is in the reference].

In *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir 1984), the Federal Circuit reversed a district court holding of invalidity of patents and held that:

> The "difference" may have seemed slight (as has often been the case with some of history's great inventions, e.g., the telephone) but it may also have been the key to success and advancement in the art resulting from the invention. Further, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art.

The Federal Circuit has also continually cautioned against myopic focus on the obviousness of the difference between the claimed invention and the prior art rather than on the obviousness vel non of the claimed invention as a whole relative to the prior art as §103 requires. See, e.g., *Hybritech Inc. v. Monoclonal Antibodies, Inc.* 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986).

In the present case, the reference fails to teach all the limitations of the claimed invention. Thus, the rejection is improper because, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. In this context, 35 USC §103 provides that:

> A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the *subject matter* as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Because all the limitations of claims 1 and 21 have not been met by the *de la Huerga* patent, it is impossible to render the subject matter as a whole obvious. Thus the explicit terms of the statute have not been met and the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

In view of the above, it is respectfully submitted that remaining claims 1, 2, 5–7, 10-18 and 21 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,

James R. Bell
Registration No. 26,528

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HAYNES AND BOONE, L.L.P.
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 512/867-8407
Facsimile: 214/200-0853
ipdocketing@haynesboone.com

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